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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,995	10/20/2000	Dean F. Jerding	A-6687	8091

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SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
5030 SUGARLOAF PARKWAY
LAWRENCEVILLE, GA 30044

EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/692,995

Applicant(s)

JERDING ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80,82,83,85,86 and 90-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 80,82,83,85,86 and 90-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Priority***

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) or 35 U.S.C. 120. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/590,488, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The subject matter that is common between the two application appears to be related to the overall system architecture and ordering process as illustrated in Figures 1-6. Figure 19C of the earlier '488 application, appears to correspond to Figure 7 of the instant application. However, the earlier filed application does not appear to disclose or illustrate the particular usage of the "bookmark" process as claimed. Accordingly, the claimed subject matter shall not receive the priority of an earlier filling with respect to the '488 application.

Similarly, the disclosure of the prior-filed application, Application No. 09/590,488, fails to provide adequate support or enablement in the manner provided by the first paragraph of

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35 U.S.C. 112 for one or more claims of this application. The provisional application generally introduces the concept of a bookmark in conjunction with the “current rental screen” (Page 13). Accordingly, the provisional application does not appear to perform bookmarking without interrupting the visual presentation or only utilizing local memory as claimed. For the purposes of evaluation of prior art with respect to applicant’s claim to priority, the application filing date shall be the filing date of the instant application or 20 October 2000.

Claim Objections

2. Claim 96 is objected to because the phrase “information related to the visual scene stored only the memory of the STT” should be amended to read “information related to the visual scene stored only in the memory of the STT” Appropriate correction is required.

Response to Arguments

3. Applicant's arguments with respect to claims 80, 82, 83, 85, 86, and 90-101 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 80, 82, 83, 85, 86, 90-92, and 96-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302 B2) in view of Lewis et al. (WO 00/04726 A2).

In consideration of claims 80, the White et al. reference discloses a “method implemented by a television set-top terminal (STT)” [14] coupled via a “bi-directional communication network” [22] to a “server” [12]. The method comprises “receiving via a tuner” [60] in the “STT” [14] a “video presentation provided by the server” [12] “located in a cable television headend” [12] wherein the “video presentation is a video-on-demand presentation” and “outputting by the STT at least a portion of the video presentation as a video-on-demand television signal” [44] (Col 2, Lines 17-32; Col 3, Lines 9-12 and 28-40) responsive to a user request for the delivery/presentation of video-on-demand programming (Col 3, Line 66 – Col 5, Line 27). While the reference teaches that the system is operable to facilitate and control the particular playback of the on-demand presentation from the “server” [12] in association with various video playback commands, the reference is silent with respect to the particular ‘bookmarking’ as claimed.

In an analogous art directed towards television systems, the Lewis reference discloses a method that is described as being applicable to any digital video apparatus that allows for the digital video apparatus to quickly locate a particular data block and begin playback from a selected location (Figure 5; Page 3, Lines 14-21; Page 8, Line 19 – Page 9, Line 10). In particular, the reference discloses “receiving a first user input associated with bookmarking a visual scene contained in [a] video presentation, including receiving a character sequence to be assigned to the visual scene while the video presentation is being presented to the user” (Page 6, Lines 1-10; Page 6, Line 25 – Page 7, Line 5; Page 7, Lines 22-25). The system “stores information related to the visual scene in a memory of the . . . [digital video apparatus] responsive to receiving the first user input, including storing only in the memory of the [digital video apparatus] information related to the visual scene in response to the receiving the first user input, including storing only in the memory of the STT data corresponding to the character sequence in response to receiving the user input configured to assign the character sequence to the visual scene” (Page 7, Lines 6-11; Page 8, Lines 13-18) and subsequently “outputs . . . at least another portion of the video presentation” in association with the continual playback during/after bookmarking. After the establishment of a bookmarked scene, the method involves “receiving a second user input configured to request . . . the visual scene in the video presentation after the . . . [digital video apparatus] has output at least another portion of the video presentation” whereupon the system “requests”, “receives”, and “outputs . . . a portion of the video presentation starting from a location corresponding to the visual scene responsive to the second user input, wherein the location corresponding to the visual scene is identified by the . . . [digital video apparatus]

using the information related to the visual scene, including using information related to the visual scene stored only in the [digital video apparatus]" (Page 6, Lines 1-20; Page 7, Lines 1-5; Page 7, Line 25 – Page 8, Line 13). Accordingly, it would have been obvious to one having ordinary skill in the art to modify the VOD playback system [10] and in particular the digital video apparatus or 'STT' [14] of White et al. to "receive a first user input associated with bookmarking a visual scene contained in the video presentation, including receiving a character sequence to be assigned to the visual scene while the video presentation is being presented to the user; storing information related to the visual scene in a memory of the STT responsive to receiving the first user input, including storing only in the memory of the STT information related to the visual scene in response to receiving the first user input, including storing only in the memory of the STT data corresponding to the character sequence in response to receiving the user input configured to assign the character sequence to the visual scene; outputting by the STT at least another portion of the video presentation as a video-on-demand television signal; receiving a second user input configured to request from the headend the visual scene in the video presentation after the STT has output the at least another portion of the video presentation; responsive to receiving the second user input, requesting by the STT that the headend send the video presentation beginning from the requested video scene; receiving by the STT from the headend the video presentation beginning from the requested video scene; and outputting by the STT a video-on-demand television signal comprising a portion of the video presentation starting from a location corresponding to the visual scene responsive to the second user input, wherein the location corresponding to the visual scene is identified by the STT using the information related to the

visual scene, including using information related to the visual scene stored only in the STT” for the purpose of advantageously providing a method that allows the user to avoid the inconvenience of having to manipulate various keys in order to locate and start playback from a selected location within a video presentation (Lewis et al.: Page 2, Lines 4-14).

Claim 82 is rejected wherein the method further comprises “receiving a plurality of user inputs configured to assign a plurality of respective character sequences corresponding to a plurality of respective visual scenes that were bookmarked responsive to a plurality of respective user inputs” (Lewis et al.: Page 8, Lines 30 – Page 8, Line 5).

Claim 83 is rejected wherein the method further “receives a user input configured to request information related to the visual scene in the video presentation” [128] and “providing the requested information responsive to receiving the user input configured to request information” (Lewis et al.: Page 6, Line 31 – Page 7, Line 1; Page 8, Line 19 – Page 9, Line 10).

Claims 85 and 86 are rejected wherein the method further comprises “outputting information confirming that the visual scene has been bookmarked wherein the information [includes at least one of a banner and an icon and] overlays a minority portion of a television screen being used to display the video presentation” as illustrated in Figure 4 of Lewis et al.

Claim 90 is rejected wherein the “visual scene is associated with a bookmark list associated with a plurality of visual scenes associated with a plurality of respective user inputs” which served to establish those bookmarks (Lewis et al.: Page 6, Line 25 – Page 7, Line 11; Page 7, Line 30 – Page 8, Line 12).

Claim 91 is rejected wherein the method further comprises “associating a plurality of visual scenes with a plurality of respective bookmark lists associated with a plurality of respective users responsive to a plurality of respective user inputs” (Lewis et al.: Page 6, Line 25 – Page 7, Line 11; Page 7, Line 30 – Page 8, Line 12; Page 8, Lines 25-27).

Claim 92 is rejected wherein the method further comprises “associating a plurality of visual scenes with a plurality of respective bookmark lists associated with a plurality of respective video presentations responsive to a plurality of respective user inputs” (Page 7, Line 30 – Page 8, Line 5).

In consideration of claims 96, the White et al. reference discloses a “television set-top terminal” [14] coupled via a “bi-directional communication network” [22] to a “server” [12] “located remotely in a cable television headend” [12]. The “STT” [14] comprises a “tuner” [60] configured to receive a motion video presentation provided by the server located in the cable television headend” [12] wherein the “video presentation is a video-on-demand presentation”, a “memory” [40], and a “processor” [38] that is “programmed to enable the STT to output at least a portion of the motion video presentation as a video-on-demand television signal” [44] (Col 2, Lines 17-32; Col 3, Lines 9-12 and 28-40) responsive to a user request for the delivery/presentation of video-on-demand programming (Col 3, Line 66 – Col 5, Line 27). While the reference teaches that the system is operable to facilitate and control the particular playback of the on-demand presentation from the “server” [12] in association with various video playback commands, the reference is silent with respect to the particular ‘bookmarking’ as claimed.

In an analogous art directed towards television systems, the Lewis reference discloses a process that is described as being applicable to any digital video apparatus that allows for the digital video apparatus to quickly locate a particular data block and begin playback from a selected location (Figure 5; Page 3, Lines 14-21; Page 8, Line 19 – Page 9, Line 10). In particular, the reference discloses “stor[ing] information related to the visual scene contained in the video presentation only in the memory of the . . . [digital video apparatus] responsive to receiving a first user input associated with the visual scene, without stopping output of the motion video presentation, wherein the first user input includes a character sequence to be assigned to the visual scene, and wherein the information related to the visual scene includes data corresponding to the character sequence” (Page 6, Lines 1-10; Page 6, Line 25 – Page 7, Line 11; Page 7, Lines 22-25; Page 8, Lines 13-18) and subsequently “output[ing] . . . at least another portion of the video presentation” in association with the continual playback during/after bookmarking. After the establishment of a bookmarked scene, the digital video apparatus “receives a second user input configured to request . . . the visual scene in the video presentation after the . . . [digital video apparatus] has output at least another portion of the video presentation” whereupon the system “requests”, “receives”, and “outputs . . . a portion of the motion video presentation starting from a location corresponding to the visual scene, including using information related to the visual scenes stored only in the [digital video apparatus], wherein the . . . signal comprising the portion of the motion video presentation starting from a location corresponding to the visual scene is output after the at least another portion of the motion video presentation is output as a . . . television signal” (Page 6, Lines 1-20; Page 7, Lines 1-5; Page 7, Line 25 – Page 8, Line 13). Accordingly, it

would have been obvious to one having ordinary skill in the art to modify the VOD playback system [10] and in particular the digital video apparatus or 'STT' [14] of White et al. to "store information related to a visual scene contained in the motion video presentation only in the memory of the STT responsive to the STT receiving a first user input associated with the visual scene, without stopping output of the motion video presentation, wherein the first user input includes a character sequence to be assigned to the visual scene, and wherein the information related to the visual scene includes data corresponding to the character sequence, output at least another portion of the motion video presentation as a video-on-demand television signal, receive a second user input configured to request from the headend the visual scene in the video presentation after the STT has output the at least another portion of the motion video presentation, responsive to receiving the second user input at the STT, request that the headend send the motion video presentation beginning from the requested visual scene, receive from the headend the motion video presentation beginning from the requested visual scene, and output responsive to the STT receiving a second user input a video-on-demand television signal comprising a portion of the motion video presentation starting from a location corresponding to the visual scene, including using information related to the visual scene stored only [in] the memory of the STT, wherein the video-on-demand television signal comprising the portion of the motion video presentation starting from a location corresponding to the visual scene is output after the at least another portion of the motion video presentation is output as a video-on-demand television signal" for the purpose of advantageously providing a method that allows the user to avoid the

inconvenience of having to manipulate various keys in order to locate and start playback from a selected location within a video presentation (Lewis et al.: Page 2, Lines 4-14).

Claim 97 is rejected wherein the “visual scene is associated with a bookmark list associated with a plurality of visual scenes corresponding to a plurality of respective user inputs” which served to establish those bookmarks (Lewis et al.: Page 6, Line 25 – Page 7, Line 11; Page 7, Line 30 – Page 8, Line 12).

Claim 98 is rejected wherein the “processor is programmed to associate a plurality of visual scenes with a plurality of respective bookmark lists associated with a plurality of respective users responsive to a plurality of respective user inputs” (Lewis et al.: Page 6, Line 25 – Page 7, Line 11; Page 7, Line 30 – Page 8, Line 12; Page 8, Lines 25-27).

Claim 99 is rejected wherein the “processor is programmed to associate a plurality of visual scenes with a plurality of respective bookmark lists associated with a plurality of respective motion video presentations responsive to a plurality of respective user inputs” (Page 7, Line 30 – Page 8, Line 5).

Claim 100 is rejected wherein the “processor is configured to prompt the user to provide input indicating whether the data is to be deleted from the memory of the STT” (Lewis et al.: Page 7, Lines 1-11).

7. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302 B2), in view of Lewis et al. (WO 00/04726 A2), and in further view of Dunn et al. (US Pat No. 5,861,906).

Regarding claim 93, taken in combination, the Lewis et al. reference discloses “prompting the user to provide input indicating whether the information is to be deleted from

the memory of the STT” or alternatively allowing for the bookmarks to be saved and later called back up as required by the user (Page 7, Lines 1-11; Page 8, Lines 134-18). The combined references, however, are silent with respect to the particular step being performed ‘after expiration of a rental access period corresponding to the video presentation’. In an analogous art pertaining to television systems, the Dunn et al. reference discloses a method for ordering and processing the rental of a video which ‘expires’ and may subsequently be reordered (Col 11, Lines 37-53). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined teachings to comprise a ‘expiration of a rental access period’ for the purpose of providing a video-on-demand rental experience that is conveniently organized and familiar to a subscriber (Dunn et al.: Col 1, Lines 39-52). Subsequently, taken in combination, the particular step such that “after expiration of a rental access period corresponding to the video presentation, prompting the user to provide input indicating whether the information is to be deleted from the memory of the STT” is met such that the user is spared the inconvenience of having to reestablish ‘bookmarks’ for a given presentation if so desired.

8. Claims 94, 95, and 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302 B2), in view of Lewis et al. (WO 00/04726 A2), and in further view of Wang (US Pat No. 6,501,902 B1).

In consideration of claims 94 and 101, the combined references are silent with respect to further “storing an image corresponding to the visual scene in a memory of the STT responsive to the receiving the first user input”. In an analogous art pertaining to television systems, the Wang reference discloses “storing an image corresponding to [a] visual scene in

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a memory . . . responsive to receiving [a] first user input” corresponding to the establishment of a bookmark (Col 3, Lines 31-41). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined references to “store an image corresponding to the visual scene in a memory of the STT responsive to the receiving the first user input” for the purpose of provide a method for the user to simply and easily remember a bookmarked video scene (Wang: Col 1, Lines 51-60).

Claim 95 is rejected in light of the combined references wherein "said second user input requesting said visual scene corresponding to a thumbnail image corresponding to the visual scene, said thumbnail image being simultaneously provided with a plurality of thumbnail images corresponding to a plurality of visual scenes in the video presentation" as illustrated in conjunction with Figure 3 of Wang.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SEB

September 5, 2006

Scott Beliveau
Primary Examiner
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